

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. BLACK

Appeal 2007-3884
Application 10/005,889
Technology Center 1600

Decided: November 14, 2007

Before DONALD E. ADAMS, LORA M. GREEN, and
NANCY J. LINCK, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 8-17, 29-31, and 35-37. We have jurisdiction under 35 U.S.C. § 6(b). Claim 8 is representative of the claims on appeal, and reads as follows:

8. A circuit for detecting biomolecules *in vivo*, the circuit comprising:

an optical radiation source configured for *in vivo* use that emits first optical radiation;

an optical radiation detector configured for *in vivo* use that detects second optical radiation emitted by excited labeled binding molecules;
and

a processor circuit, coupled to the optical radiation source and the optical radiation detector, wherein the processor circuit is configured to release fluorescently labeled antibodies selected to bind with predetermined Tumor Specific Antigens (TSAs),

the processor circuit is further configured to activate the *in vivo* optical radiation source after a predetermined first time interval after release of the fluorescently labeled antibodies, the predetermined first time interval selected to allow a first portion of the fluorescently labeled antibodies to bind with local available TSAs and a second portion of the fluorescently labeled antibodies to become remote from the circuit so that the first optical radiation excites the first portion of the fluorescently labeled antibodies bound with the local available TSAs and does not excite the second portion of the fluorescently labeled antibodies that become remote,

the processor circuit is further configured to sense a voltage generated by the *in vivo* optical radiation detector after a second predetermined time interval, the second predetermined time interval being after emission of the first optical radiation has ceased.

The Examiner relies on the following references:

Santini	US 6,551,838 B2	Apr. 22, 2003
Gazdzinski	US 2001/0051766 A1	Dec. 13, 2001
Meyer	US 6,217,869 B1	Apr. 17, 2001
Crowley	US 6,119,031	Sep. 12, 2000
Sheppard	US 2002/0072784 A1	Jun. 13, 2002
Santini	US 6,491,666 B1	Dec. 10, 2002

We reverse.

DISCUSSION

Claims 8, 15-17, 29-31, 36, and 37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Santini '838.

In order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). The Examiner alleges that Santini '838 teaches all of the limitations of claim 8. The Examiner errs, however, in reading “configured to” as “capable of,” *i.e.*, the Examiner reads it as merely being limited to intended use. Specifically, according to the Examiner:

With respect to the recitations “for in vivo use that emits first optical radiation”, “for in vivo use that detects second optical radiation emitted by excited labeled binding molecules” and “and” “configured to release”, “configured to activate” and “configured to sense” these recitations are intended use of the circuit and a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention form [*sic*] the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, Santini . . . reads on the instantly recited claims.

(Answer 4.)

“Configure,” however, is defined as to “design, arrange, set up, or shape with a view to specific applications or uses.”¹ That definition is

¹ Configure. Dictionary.com. *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/configure> (accessed: October 26, 2007).

consistent with the case law cited by Appellants to support their assertion that “a processor that is programmed to provide a particular function is structurally different than other processor circuits that are programmed to provide a different function.” (Br. 5 (emphasis removed).)

Thus, the Examiner has not established that Santini '838 meets all of the limitations of claim 8, such as “wherein the processor circuit is configured to release fluorescently labeled antibodies selected to bind with predetermined Tumor Specific Antigens (TSAs),” and we are compelled to reverse the rejection.²

In addition, claims 9, 10-13, 14, and 35, stand rejected under 35 U.S.C. § 103(a) as being obvious over '838 as combined with various other references. As the other references do not remedy the deficiencies of Santini '838, the remainder of the rejections of record are also reversed.

² The Examiner, upon return of the administrative file, may wish to consider whether Santini '838 could be used as the basis for an obviousness rejection. In formulating such a rejection, consistent with our analysis above, the Examiner needs to address all of the limitations, including “for in vivo use that emits first optical radiation,” “for in vivo use that detects second optical radiation emitted by excited labeled binding molecules,” “configured to release,” “configured to activate,” and “configured to sense.”

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REVERSED

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